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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1945

No. 150

CLARAGE FAN COMPANY,

Petitioner,

vs.

B. F. STURTEVANT COMPANY

PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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INDEX

Subject Index

	Page
Petition for writ of certiorari	1
Summary statement of matter involved	2
First Hagen Patent	3
Second Hagen Patent	5
Jurisdiction	7
Questions presented	7
Reasons relied upon for allowance of the writ	10
Prayer	12
Brief in support of petition	13
Opinions of the courts below	13
Statement	13
Specification of errors	13
Summary of argument	13
Argument	13
Point I—The Court of Appeals for the Sixth Circuit appears to have overlooked the public interest in applying the rule of res adjudicata in this case and in not following the application of the rule of upholding the public interest as this Court stated should be done in Mercoid Corporation v. Mid-Continent Investment Co. 320 U. S. 661, 88 L. Ed. 376	13
Point II—The Court of Appeals for the Sixth Circuit has failed to give proper consideration to the public interest in holding the second Hagen patent valid, which patent the patentee Hagen now admits is merely an adaptation of the structure of the first Hagen patent, which was applied to an induced draft fan, to a forced draft fan (R. 114), and the fact that such adaptation is taught by the art; Cuno Engineering Corporation v. Automatic Devices Corporation, 314 U. S. 84; 86 L. Ed. 58; Sinclair & Carrol Company, Inc., v. Interchemical Corporation, announced May 21, 1945	16

Page

Point III—The Court of Appeals for the Sixth Circuit has failed to guard the public interest in not holding the second Hagen patent invalid on this record which shows that the adjustment of the vanes through an angle of 90 degrees is merely a matter of mechanics, and that it is merely a matter of mechanics to make the vanes of the first Hagen patent adjustable through that range of degrees and that such range of adjustment of vanes and the arrangement of the pivots of the vanes obliquely to the rotor axis is not only taught by the art of record but was done by Hagen and his associates purely as a mechanical expedient to minimize obstruction of the eye of the fan 17

Point IV—The Court of Appeals for the Sixth Circuit, by adopting and applying respondent's present theory of 100% overlapping of vanes in fully open position and construing the claims to cover petitioner's structures Exhibits B and C because they have vanes overlapping in space, has disregarded the public interest to the extent that this interpretation of the claims would make them apply to most multiple vane controls and most of the prior art patents, many of which have expired and are in the public domain. 19

Point V—The Court of Appeals for the Sixth Circuit has overlooked the public interest in holding petitioner's Exhibits B and C to infringe both patents in suit on the basis of results accomplished, and has further overlooked the public interest to the extent of giving the claims such scope as to embrace the prior art structures and has given the mechanical Claim 2 of the first Hagen patent the effect and scope of the method Claim 1 held invalid by the Court of Appeals

Page

for the First Circuit, and has unwarrantedly extended the finding of the Court of Appeals for the First Circuit 21

Point VI—This Court in the public interest should exercise its supervisory authority and review the decision of the Court of Appeals for the Sixth Circuit, determining the validity of both patents in the light of the record in this case, the admissions of the respondent herein and the respondent's presently urged theory of 100% overlapping of the vanes in fully open position, which is an incident to several prior art patents. If this Court should determine the patents in suit to be valid the rights of the public should be definitely determined by fully defining the meaning and scope of the claims, inasmuch as this has not been done by any court considering them but which, without attempting to apply to Exhibits B and C the Court of Appeals for the Sixth Circuit has, on the basis of results accomplished thereby, extended to cover prior art patents having spin control vanes overlapping in space 22

Conclusion 24

Table of Cases Cited

B. F. Sturtevant Co. v. *Massachusetts Hair & Felt Co.*, 122 F. (2d) 900 20

Cuno Engineering Corporation v. *Automatic Devices Corporation*, 314 U. S. 84; 86 L. Ed. 58 8,10,16,17,19

DeForest Radio Corporation v. *General Electric Co.*, 283 U. S. 664 17

General Electric Company v. *Wabash Appliance Corporation*, 304 U. S. 364, 82 L. Ed. 1402 8,19

Market Street Cable Railway Co. v. *Rowley*, 155 U. S. 621. 17

Mercoid Corporation v. *Mid-Continent Investment Co.*, 320 U. S. 661, 88 L. Ed. 376 7,10,13,15,21,23

Page

Motion Picture Patents Corporation v. *Universal Film Corporation*, 243 U. S. 502 21,23
Pennock v. *Dialogue*, 2 Pet. 1 21
Sinclair & Carrol Company, Inc. v. *Interchemical Corporation*, Announced May 21, 1945 (unreported), 8,10,16,17,19,21,23
United Carbon Company v. *Binney & Smith Co.*, 317 U. S. 228, 87 L. Ed. 232 8
United States v. *Masonite Corporation*, 316 U. S. 265 ... 21,23

SUPREME COURT OF THE UNITED STATES

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CLARAGE FAN COMPANY,

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vs.

B. F. STURTEVANT COMPANY

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT.

To the Honorable the Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Clarage Fan Company, prays for a writ of certiorari to the United States Circuit Court of Appeals for the Sixth Circuit to review the judgment of that Court entered on the 4th day of April, 1945 (R. 412), 65 USPQ 203, as amended on the 22nd day of May, 1945 (R. 423), not reported.

A certified transcript of record in the case, including proceedings in said Circuit Court of Appeals, is furnished herewith in compliance with the rules of this Court.

Summary Statement of Matter Involved

This suit was brought by the respondent against the petitioner for infringement of Claim 2 of the first Hagen patent 1,846,863 for Fan and Method of Operating Same (R. 263), and all four claims of the second Hagen patent 1,989,413, for Centrifugal Fan (R. 264). The United States District Court for the Western District of Michigan held all claims in suit valid and infringed by petitioner's structures exemplified by Exhibit 3 and Exhibits B and C (Findings of Fact and Conclusions of Law, R. 36). The Court of Appeals for the Sixth Circuit affirmed the judgment of the District Court (R. 412), 65 USPQ 203, and on May 22, 1945, amended its judgment (not reported).

The two Hagen patents here in suit were involved in the case of *B. F. Sturtevant Company* (*respondent herein*) v. *Massachusetts Hair & Felt Company*, in the United States District Court for the District of Massachusetts, charging infringement of the claims here involved and also method Claim 1 of the first Hagen patent by Exhibit 3.

That case was referred to a Master who found method Claim 1 of the first Hagen patent invalid, Claim 2 valid and infringed, and all four claims of the second Hagen patent invalid. The Master's finding was affirmed by the District Court (31 Fed. Supp. 975). The Court of Appeals for the First Circuit affirmed the District Court with respect to the first Hagen patent, holding method Claim 1 invalid and Claim 2 valid and infringed, but reversed the finding of the Master and the judgment of the District Court in respect to the second Hagen patent, holding all four claims valid and infringed (122 Fed. (2d) 900; Petition for Rehearing denied 124 Fed. (2d) 95; Petition for Writ of Certiorari denied, 315 U. S. 823, 86 L. Ed. 1219).

Petitioner assumed the defense of the Massachusetts case. Exhibit 3 is the same as the structure held to infringe in

the Massachusetts case. Exhibits B and C were not involved in that case.

First Hagen Patent

The principle of controlling the output of a fan by varying the spin of the entering air in the direction of rotation of the rotor of the fan is admittedly old and in fact is referred to as "ancient." This control is best accomplished by a plurality of coacting pivotally adjustable vanes and this is old in the art.

The first Hagen patent (R. 263) is an adaptation of this ancient principle of variable spin control to an induced draft fan in which the vanes are arranged in an annular series in a scroll-shaped inlet, the axes of the vanes being parallel to the axis of the rotor. The vanes are connected for simultaneous operation which is old in the art, for example in Eickhoff (R. 356, Chart Exhibit P) and the Beaudrey French patent (R. 392, Chart Exhibit U). The vanes of this Hagen patent are curved and the Court in the Massachusetts case distinguished Hagen from Eickhoff's straight vanes, pointing out the differences, 122 F. (2d) 900, at 910. On page 911 (also R. 285) the Court of Appeals for the First Circuit summarized what it considered to be Hagen's contribution in the following language:

> "It does not seem to us that it would have occurred to a mechanic or designer skilled in the art either to disregard increasing shock-loss by radically increasing the spin of the entering air *or to construct vanes of cylindrical contour* for the purpose of providing passages between them 'of substantially uniform cross-section as the vanes are moved to closed position,' so that control to minimum capacity by spin rather than by throttling would result. Thus the finding of patentable invention made by the master and confirmed and adopted by the court must stand." (Italics ours.)

Hagen sought to pre-empt this ancient principle of spin control by method Claim 1 of the first Hagen patent which the Court of Appeals for the First Circuit held invalid for lack of patentable invention. This claim was held to be invalid on the ground that if patentable novelty was present in Claim 1 it must reside in adjusting the spin through a range from substantially the full capacity of the fan to a minimum capacity thereof with a substantially tangential admission of fluid, such variation through this range being effected by increasing the spin component while reducing the area, as defined in the concluding clause of Claim 1, the claim being as follows:

> "1. A method of operating a centrifugal fan which consists in rotating the fan wheel at constant speed and controlling the output of the fan in accordance with the variations in demand thereon by supplying fluid to the fan with a spin component of velocity in the direction of rotation of the wheel, adjusting the spin through a range to produce variations in output from substantially the full capacity of the fan to a minimum capacity thereof with a substantially tangential admission of fluid, said variation from maximum output to lower outputs being effected by increasing the spin component while reducing the area through which the fluid passes at a rate not proportionately greater than the rate of increase of the spin component."

The Master held that this was merely extending the range of control by a known method and that any novelty in Claim 1 resides in results rather than method. Both Courts affirmed the finding.

Claim 2 of the first Hagen patent, held valid, is as follows:

> "2. The combination with a constant speed motor, of a centrifugal fan having a rotor, an inlet, a plurality of vanes in the inlet forming fluid directing passages to admit fluid to the rotor with a spin component of velocity in the direction of rotation of the rotor, the

vanes being adjustable to vary the output of the fan through a range from maximum capacity with the vanes open to a minimum capacity with a substantially tangential admission of fluid when the vanes are closed, adjacent vane surfaces continuously approaching parallelism and having extended overlapping portions shaped to define passages of substantially uniform cross-section as the vanes are moved toward closed position."

This must be construed to define what the Court in the Massachusetts case stated Hagen's contribution to be as distinguished from what would have occurred to a mechanic or designer in the paragraph we have quoted.

Second Hagen Patent

The second Hagen patent (R. 264), as admitted by the inventor Hagen, is merely an adaptation of the first patent to a forced draft fan (R. 114) "* * * That is all that it is supposed to be." This adaptation was old and taught by the art; in fact, some of the prior art patents show both adaptations in single patents, as in Moody 1,460,428 (R. 357, Chart Exhibits Q and R).

Whether an induced draft fan or a forced draft fan should be installed in a particular system is a matter of engineering and sometimes both are employed in a single system (R. 94), the forced draft to push the air into the system and the induced draft to pull it out of the system. With both induced and forced draft the spin control vanes are arranged in advance of the rotor; in the induced draft commonly in a scroll-shaped inlet chamber connected to a conduit, and in the forced draft in an inlet open to the air.

In the first Hagen patent the vanes are arranged in an annular series with their pivot axes parallel to the axis of the rotor. In the second Hagen patent they are arranged in an annular series with their axes oblique to the axis of

the rotor. Both arrangements are old in the art, Moody (R. 357) being an example. While the axes of the vanes in this patent are shown in the drawing at right angles to the axis of the rotor, the specification states,

> "The guide vane axes in Fig. 2 are shown in the same plane although they might be equally well contained in a conical surface having its apex in the pump axis."

In adapting the first Hagen patent to a forced draft fan the axes of the vanes were first arranged perpendicular to the axis of the rotor; as this served to choke the inlet the design was changed by moving the vanes forward in the conical throat (Hagen, R. 89).

Claim 1, which may be regarded as typical, is as follows:

> "1. A centrifugal fan comprising a rotor, a casing having an eye and a substantially conical inlet passage leading to the eye, and a plurality of vanes in the inlet pivoted on axes which are oblique to the rotor axis and substantially at right angles to the conical inlet, the vanes being adjustable about their axes from substantially wide open position in which they do not appreciably obstruct the flow of gas to the rotor through an angle of nearly 90 degrees to a closed position, throughout which adjustment they direct the entering gas to the rotor with an appreciable spin, the work done by the fan on the gas being variable in accordance with the adjustable spin introduced by the vanes at different positions."

Respondent's expert Berry states that it is a matter of mechanics to provide a 90-degree range of adjustment of the vanes in the first Hagen patent (R. 138).

Claim 1 concludes with the statement,

> "the work done by the fan on the gas being variable in accordance with the adjustable spin introduced by the vanes at different positions".

This is the same as in the first Hagen patent and in the ancient art, the principle having been discovered in the Eighteenth Century by a Swiss mathematician and physicist named Euler and reduced to an equation.

The added hub element on the rotor axis of Claim 2 of the second Hagen patent is old in the art. The added "means for simultaneously and uniformly adjusting the vanes about their axes" of Claims 3 and 4 are common in the old art.

Jurisdiction

1. This is a suit arising under the Patent Laws of the United States, Judicial Code, Sec. 24 (7) (28 U. S. C., Sec. 41 (7).

2. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U. S. C., Sec. 347).

3. The date of the judgment which petitioner seeks to have reviewed is April 4, 1945 (R. 412), as amended May 22, 1945 (R. 423).

Questions Presented

1. Whether public interests are not paramount in the application of rules of res adjudicata in this cause as was held by this Court in *Mercoid Corporation* v. *Mid-Continent Investment Co.*, 320 U. S. 661, 88 L. Ed. 376.

2. Whether a claim of a patent should be held valid which is so indefinite and vague as to permit the owner of the patent (respondent) to urge one interpretation in the *Massachusetts* case in order to support a charge of infringement by Exhibit 3, and to advance another theory of interpretation in the present case in order to support a charge of infringement by Exhibits B and C. The interest of the public and equity to the petitioner demand that a claim capable of being so manipulated should be held invalid

under the established rules of law applied to this Court in

United Carbon Company v. *Binney & Smith Co.*, 317 U. S. 228, 87 L. Ed. 232; and

General Electric Company v. *Wabash Appliance Corporation*, 304 U. S. 364, 82 L. Ed. 1402.

3. Whether public interest should not be considered in determining validity of the second Hagen patent which admittedly is merely an adaptation of the first Hagen patent, applied to an induced draft fan, to a forced draft fan (R. 114), such adaptation being taught by several prior patents,

Sinclair & Carrol Company, Inc., v. *Interchemical Corporation*, Announced May 21, 1945 (unreported);

Cuno Engineering Corporation v. *Automatic Devices Corporation*, 314 U. S. 84, 86 L. Ed. 58.

4. Whether the Court of Appeals for the Sixth Circuit, in view of the statement of the inventive step which the Court of Appeals for the First Circuit held was taken by Hagen, properly held petitioners structures Exhibits B and C to infringe the patents in suit, and whether the Court of Appeals for the Sixth Circuit has not unwarrantedly extended the findings of the Court of Appeals for the First Circuit to the detriment of public interest and petitioner's rights.

5. Whether respondent's urging the theory of 100% overlap when the vanes are in fully open position is such a shift of theory from that taken by respondent in the *Massachusetts* case as warrants refusal to apply the doctrine of res adjudicata.

6. Whether overlapping of vanes in space should be regarded as imparting patentable novelty to the patents in suit or in determining infringement thereof by Exhibits B and C when such overlapping in space is an incident to all

prior art multiple vane spin controls to the same degree as is present in petitioner's structures Exhibits B and C, held to constitute infringements because of such overlapping in space, the public interests being thereby disregarded and permitting respondent to reclaim and recapture admittedly ancient principles of spin control and structures of patents long since expired.

7. Whether the application of the doctrine of res adjudicata to Exhibit 3 justifies holding Exhibits B and C to constitute infringement on the ground that they produce substantially the same results in spin control in substantially the same way as Exhibit 3 when, as a matter of fact, they are within the range of spin control of structures embodying the prior art, and Exhibit B has substantially the same as and Exhibit C has substantially less range of spin control than structures embodying the prior art, and this spin control is accomplished in both Exhibits B and C in the same way and by the same means as the spin controls of the prior art.

8. Whether this Court should in the public interest exercise its supervisory authority in reviewing the decision in this cause, not only determining the validity of both patents in suit in the light of the record in the present case, the admissions of the respondent herein, and the respondent's presently urged theory of 100% overlapping of vanes in fully open position which is incident to several prior art patents, but also, if the patents are valid or determined to be valid, defining the rights of the public by defining the meaning and scope of the claims, which has not so far been done by any court considering them, but which have been extended by the Court of Appeals for the Sixth Circuit to include practically all prior art patents on multiple vane spin control.

Reasons Relied Upon for Allowance of the Writ

I. The Court of Appeals for the Sixth Circuit appears to have overlooked the public interest in applying the rule of res adjudicata in this case and in not following the application of the rule of upholding the public interest as this Court stated should be done in *Mercoid Corporation* v. *Mid-Continent Investment Co.*, 320 U. S. 661, 88 L. Ed. 376.

II. The Court of Appeals for the Sixth Circuit has failed to give proper consideration to the public interest in holding the second Hagen patent valid, which patent the patentee Hagen now admits is merely an adaptation of the structure of the first Hagen patent, which was applied to an induced draft fan, to a forced draft fan (R. 114), and the fact that such adaptation is taught by the art;

Cuno Engineering Corporation v. *Automatic Devices Corporation*, 314 U. S. 84; 86 L. Ed. 58;

Sinclair & Carrol, Inc. v. *Interchemical Corporation*, announced May 21, 1945 (unreported).

III. The Court of Appeals for the Sixth Circuit has failed to guard the public interest in not holding the second Hagen patent invalid on this record which shows that the adjustment of the vanes through an angle of 90 degrees is merely a matter of mechanics, and that it is merely a matter of mechanics to make the vanes of the first Hagen patent adjustable through that range of degrees and that such range of adjustment of vanes and the arrangement of the pivots of the vanes obliquely to the rotor axis is not only taught by the art of record but was done by Hagen and his associates purely as a mechanical expedient to minimize obstruction of the eye of the fan.

IV. The Court of Appeals for the Sixth Circuit, by adopting and applying respondent's present theory of 100%

overlapping of vanes in fully open position and construing the claims to cover petitioner's structures Exhibits B and C because they have vanes overlapping in space, has disregarded the public interest to the extent that this interpretation of the claims would make them apply to most multiple vane controls and most of the prior art patents, many of which have expired and are in the public domain.

V. The Court of Appeals for the Sixth Circuit has overlooked the public interest in holding petitioner's Exhibits B and C to infringe both patents in suit on the basis of results accomplished, and has further overlooked the public interest to the extent of giving the claims such scope as to embrace the prior art structures and has given the mechanical Claim 2 of the first Hagen patent the effect and scope of the method Claim 1 held invalid by the Court of Appeals for the First Circuit, and has unwarrantedly extended the finding of the Court of Appeals for the First Circuit.

VI. This Court in the public interest should exercise its supervisory authority and review the decision of the Court of Appeals for the Sixth Circuit, determining the validity of both patents in the light of the record in this case, the admissions of the respondent herein and the respondent's presently urged theory of 100% overlapping of the vanes in fully open position, which is an incident to several prior art patents. If this Court should determine the patents in suit to be valid the rights of the public should be definitely determined by fully defining the meaning and scope of the claims, inasmuch as this has not been done by any court considering them but which, without attempting to apply to Exhibits B and C the Court of Appeals for the Sixth Circuit has, on the basis of results accomplished thereby, extended to cover prior art patents having spin control vanes overlapping in space.

Prayer

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued to the Court of Appeals for the Sixth Circuit to the end that this cause may be reviewed and determined by this Court in accordance with the principles of law heretofore announced by it and that the judgment of the Court of Appeals as to the finding of res adjudicata and the application of the rules of res adjudicata in this cause be reversed; that the finding of validity of Claim 2 of Hagen patent 1,846,863 and of each of the four claims of the Hagen patent 1,989,413 and the finding of infringement of all of said claims by petitioner's structures Exhibits B and C be reversed; and that petitioner be granted such other and further relief as may be proper.

CLARAGE FAN COMPANY,
By OTIS A. EARL,
FRED L. CHAPPELL,
WM. S. HODGES,
Attorneys for Petitioner.

BRIEF IN SUPPORT OF PETITION

Opinions of the Courts Below

The opinion of the District Court in the form of Findings of Fact and Conclusions of Law appears at R. 36.

The opinion of the Court of Appeals for the Sixth Circuit is reported 65 USPQ 203 (R. 412). For the amendment thereto (unreported) see R. 423.

Statement

It is believed that the facts and issues are sufficiently stated in the summary statement of the petition and in the statement of questions presented.

Specification of Errors

The specification of errors relied upon are the reasons for the allowance of the writ as set forth in the petition.

Summary of Argument

The points of the argument are those set forth in the petition as reasons for allowance of the writ.

Argument

POINT I. The Court of Appeals for the Sixth Circuit appears to have overlooked the public interest in applying the rule of res adjudicata in this case and in not following the application of the rule of upholding the public interest as this Court stated should be done in *Mercoid Corporation* v. *Mid-Continent Investment Co.*, 320 U. S. 661, 88 L. Ed. 376.

It is believed that the Court of Appeals for the Sixth Circuit has overlooked the public interest in applying the rule of res adjudicata in this case. The record in this case differs materially from the record in the Massachusetts case.

While petitioner's structure Exhibit 3 was involved in the Massachusetts case, Exhibits B and C were not involved there.

In order to urge infringement by Exhibits B and C respondent evolved its present overlapping in space theory, 100% overlap with vanes in fully open position in which position they perform no work. Overlapping in space is an incident to all adjustable multiple vane controls, including several expired patents. The Court of Appeals for the Sixth Circuit quoted from the opinion of the Court of Appeals for the First Circuit as follows:

> "'It does not seem to us that it would have occurred to a mechanic * * * skilled in the art either to disregard increasing shock-loss by radically increasing the spin of the entering air or to construct vanes of cylindrical contour for the purpose of providing passages between them "of substantially uniform cross section as the vanes are moved to closed position" so that control to minimum capacity by spin rather than by throttling would result. Thus the finding of patentable invention made by the Master and confirmed and adopted by the Court must stand.'"

and then added,

> "We think that these passages show clearly, that the court's conception of the invention lay in the overlapping of the vanes in space to provide passages of uniform cross section, for obviously, if they did not overlap in space, passages could not occur, or be provided between them."

There are passages between the vanes of all multiple vane spin controls of the prior art and they overlap in space. Eickhoff (R. 356, Chart Exhibit T), Moody (R. 357, Chart Exhibit Q), Moody (R. 359), Beaudrey (R. 392, Chart Exhibit U), and Brown, Boveri (R. 371, Chart Exhibit T)

are examples; but note that the Court of Appeals for the First Circuit states,

> "It does not seem to us that it would have occurred to a mechanic * * * skilled in the art either to disregard increasing shockloss by radically increasing the spin of the entering air *or to construct vanes of cylindrical contour for the purpose of providing passages between them* 'of substantially uniform cross section as the vanes are moved to closed position", (underscoring ours).

and that Claim 2 of the first Hagen patent defines the vanes as providing

> "substantially tangential admission of fluid when the vanes are closed, adjacent vane surfaces continuously approaching parallelism and having extended overlapping portions *shaped* to define passages of substantially uniform cross section as the vanes are moved toward closed position." (underscoring ours).

This "shaped" is the "cylindrical contour" referred to by the Court of Appeals for the First Circuit.

Petitioner's structures Exhibits B and C are the same as prior art patents so far as overlapping in space is concerned, for example see comparative chart Exhibit W, in which Exhibits B and C are compared to Moody 1,460,428.

It is respectfully urged that the public interests are paramount and that the Court of Appeals for the Sixth Circuit should have followed the application of the rule of res adjudicata as laid down by this Court in *Mercoid Corporation* v. *Mid-Continent Investment Co.*, 320 U. S. 661, 88 L. Ed. 376.

It is also respectfully urged that as a matter of public interest the Court of Appeals should have considered the question of validity and infringement as presented by the present record, and should not have extended or applied

the doctrine of res adjudicata beyond the findings of the Court of Appeals for the First Circuit and broadened the interpretation of the claims in suit to include practically all multiple vane controls of the prior art, which was done in finding infringement by Exhibits B and C, both on the basis of results accomplished and on the theory of overlapping of vanes in space.

POINT II. The Court of Appeals for the Sixth Circuit has failed to give proper consideration to the public interest in holding the second Hagen patent valid, which patent the patentee Hagen now admits is merely an adaptation of the structure of the first Hagen patent, which was applied to an induced draft fan, to a forced draft fan (R. 114), and the fact that such adaptation is taught by the art;

Cuno Engineering Corporation v. *Automatic Devices Corporation*, 314 U. S. 84, 86 L. Ed. 58;
Sinclair & Carrol, Inc. v. *Interchemical Corporation*, announced May 21, 1945 (unreported).

The patentee Hagen now admits (R. 114) that the second Hagen patent is merely an adaptation of the structure of the first Hagen patent, which was applied to an induced draft fan, to a forced draft fan. This application or adaptation is taught by the art, some prior art patents showing both forms, that is, a closed inlet such as shown in the first Hagen patent in an induced draft fan and the open inlet such as shown in the second Hagen patent in a forced draft fan. This adaptation is graphically illustrated in defendant's chart, Exhibit H, where the right hand end of the figure shows an induced draft adaptation and the left hand end a forced draft adaptation. Fig. 1 of Moody (R. 357) in chart Exhibit Q shows an induced draft adaptation, while Fig. 2 of Moody, Chart Exhibit R, shows a forced draft adaptation. Induced draft and forced draft fans are some-

times embodied in the same system (R. 94). Such an adaptation cannot amount to or impart patentable novelty under such authorities as

Cuno Engineering Corporation v. *Automatic Devices Corporation*, 314 U. S. 84, 86 L. Ed. 58;

Sinclair & Carrol v. *Interchemical Corporation*, announced May 21, 1945 (unreported);

DeForest Radio Corporation v. *General Electric Co.*, 283 U. S. 664;

Market Street Cable Railway Co. v. *Rowley*, 155 U. S. 621.

POINT III. The Court of Appeals for the Sixth Circuit has failed to guard the public interest in not holding the second Hagen patent invalid on this record which shows that the adjustment of the vanes through an angle of 90 degrees is merely a matter of mechanics, and that it is merely a matter of mechanics to make the vanes of the first Hagen patent adjustable through that range of degrees and that such range of adjustment of vanes and the arrangement of the pivots of the vanes obliquely to the rotor axis is not only taught by the art of record but was done by Hagen and his associates purely as a mechanical expedient to minimize obstruction of the eye of the fan.

Claim 1 of the second Hagen patent calls for a structure comprising a casing having an eye and a substantially conical inlet passage leading to the eye, which is old in Moody and other prior art. It further calls for a plurality of vanes in the inlet pivoted on axes which are oblique to the rotor axis and substantially at right angles to the conical inlet. While in Fig. 2 of Moody 1,460,428 (R. 357) and in Moody 1,578,843 (R. 359) the axes of the vanes are shown perpendicular to the rotor axis, both patents state that the axes of the vanes might well be contained in a conical surface

having its apex in the pump axis, or, in other words, arranged oblique to the rotor axis. See also Keller (R. 362).

> "The stop walls [vanes] can be radially or longitudinally adjustable or pivoted about a radial, longitudinal or oblique axis, or alter their position relatively to the inlet of the disc, in any practical manner."

The vanes are arranged at right angles to the conical inlet as called for by the claims of Hagen to prevent interference of the ends of the vanes with the wall of the inlet as they swing on their pivots. This is an obvious mechanical expedient and it is old in the art, see Moody 1,728,435, Figs. 7 and 8 (R. 361).

The patentee Hagen testified in this case (R. 89) that when the idea of applying the control to forced draft first occurred to "us" the vanes were placed on axes perpendicular to the fan shaft which brought them into the eye, the small diameter of the inlet. This cut down eye area or capacity and resulted in reducing the capacity of the fan, and therefore the vanes were moved farther forward into a larger portion of the inlet so that they would not reduce capacity of the eye; surely a mere matter of mechanics.

The claims of the second Hagen patent call for movement of the vanes through an angle of 90 degrees to a closed position. Respondent's expert Berry states that it is a mere matter of mechanics to provide a 90 degree range of adjustment of the vanes in the first Hagen patent (R. 138). That is also old in the prior art and should not be taken from the public domain to extend Hagen's monopoly by the issue of the second Hagen patent. The first Hagen patent was applied for August 4, 1927, and issued February 23, 1932. The second Hagen patent was applied for October 31, 1929, and issued January 9, 1935.

As to Claims 2, 3 and 4 of the second Hagen patent, the additional feature of the hub in Claim 2 is old in the art, in Moody for example. Claim 3 is Claim 1 with the addi-

tional element, "means for simultaneously and uniformly adjusting the vanes about their axes", which is common in prior art multiple vane output control structures. Claim 4 is Claim 2 with this element added.

It is respectfully urged that the Court of Appeals for the Sixth Circuit has failed to give proper consideration to the public interest in holding the claims of the second Hagen patent to involve inventive novelty, and that the rules of res adjudicata should not be applied in disregard of the public interest where claims of a patent are so obviously lacking in invention or are capable of being stretched beyond recognition,

Cuno Engineering Corporation v. *Automatic Devices Corporation*, 314 U. S. 84; 86 L. Ed. 58;

Sinclair & Carrol v. *Interchemical Corporation*, announced May 21, 1945 (unreported); *United Carbon Company et al* v. *Binney & Smith Co.*, 317 U. S. 228, 87 L. Ed. 232;

General Electric Company v. *Wabash Appliance Corporation*, 304 U. S. 364, 82 L. Ed. 1402.

POINT IV. The Court of Appeals for the Sixth Circuit, by adopting and applying respondent's present theory of 100% overlapping of vanes in fully open position and construing the claims to cover petitioner's structures Exhibits B and C because they have vanes overlapping in space, has disregarded the public interest to the extent that this interpretation of the claims would make them apply to most multiple vane controls and most of the prior art patents, many of which have expired and are in the public domain.

In Finding of Fact 32 (R. 43) the District Court held:

"32. In the theory of a 100% overlap when the vanes are in fully open position, there is no such shifting of theory by plaintiff from that taken by it in the Massachusetts case, as to warrant refusal to apply the doctrine of res adjudicata."

In fully open 100% overlap position the vanes perform no work and are merely obstructions to the flow of air. On this presently urged theory, approved by the Court of Appeals for the Sixth Circuit, the degree of overlapping in space begins to decrease immediately the vanes are moved from fully open toward closed position, until in Exhibits B and C there is no overlapping in space or in any other sense when the vanes are closed or as they approach closed position.

The Sixth Circuit Court of Appeals has held that this overlapping in space should be read into the opinion of the First Circuit Court of Appeals. There is no word in that opinion about overlapping in space. There is discussion about overlapping of vanes in the sense of the edge of one vane projecting beyond and in overlapping relation to the edge of the adjacent vane when the vanes are moved toward closed position. The First Circuit likened the arrangement of vanes of the first Hagen patent to the staves of a barrel and added (122 Fed. 2d 900 at page 905, column 2),

> "In likening Hagen's vanes to the staves of a barrel it must be borne in mind that, when in closed position, they do not meet edge to edge like barrel staves, but overlap one another."

The vanes of petitioner's structures Exhibits B and C do not overlap one another when closed. In Exhibit B they meet edge to edge, see Cuts 7 and 8 of Chart Exhibit G. In Exhibit C there is a substantial opening between them, see cut 9, Exhibit G. (See also photograph of Exhibit C, R. 350, Comparative Chart Defendant's Structures B and C, Exhibit W, and Comparative Chart, Diagrammatic Views of Vanes Defendant's Structures B and C, Certain Prior Art Patents and Hagen's First and Second Patents, Exhibit Y).

Overlapping of vanes in space is common to all prior art multiple vane controls; indeed, it is the very essence of all

such vanes (Eickhoff, R. 356, Chart Exhibit T; Moody, R. 358; Chart Exhibits Q and R; Moody 1,728,432, Chart Exhibit S; Brown, Boveri, R. 372, Chart Exhibit T; Beaudrey, R. 392, Chart Exhibit U.) In all of these patents the vanes overlap in space and overlapping in space cannot be the determining factor.

Not only the public interest but the primary purpose of the patent system is disregarded when claims are held to be valid and so construed as to cover disclosures of the prior art as has been done by the Court of Appeals for the Sixth Circuit in applying respondent's presently urged theory of overlapping in space to find infringement by Exhibits B and C,

Sinclair & Carrol v. *Interchemical Corporation* announced May 21, 1945 (unreported); *Pennock* v. *Dialogue*, 2 Pet. 1;

Motion Picture Patents Corporation v. *Universal Film Corporation*, 243 U. S. 502; *United States* v. *Masonite Corporation*, 316 U. S. 265 (see p. 278);

Mercoid Corporation v. *Mid-Continent Investment Company*, 320 U. S. 661.

POINT V. The Court of Appeals for the Sixth Circuit has overlooked the public interest in holding petitioner's Exhibits B and C to infringe both patents in suit on the basis of results accomplished, and has further overlooked the public interest to the extent of giving the claims such scope as to embrace the prior art structures and has given the mechanical Claim 2 of the first Hagen patent the effect and scope of the method Claim 1 held invalid by the Court of Appeals for the First Circuit, and has unwarrantedly extended the finding of the Court of Appeals for the First Circuit.

The District Court and the Court of Appeals for the Sixth Circuit made no attempt to apply the claims in suit to petitioner's structures Exhibits B and C but found infringement on the basis of results accomplished; the results

accomplished being spin control through a range not stated or defined by either Court and the results accomplished being within the range of embodiments of prior art structures, the means for accomplishing the results being also old in the prior art.

The Court of Appeals for the First Circuit held method Claim 1 of the first Hagen patent invalid as merely, if anything, the carrying forward of the old method of spin control by old means disclosed in several prior patents. However, in this case the Court of Appeals for the Sixth Circuit, on the basis of results accomplished, has extended the mechanical claims of the Hagen patents to include Exhibits B and C although they embody old mechanisms and the results accomplished are within the range of structures embodying Eickhoff (Exhibit LL, Test Chart of Exhibits B and C, R. 398, and Exhibit NN, 3 sheets, separate Chart Exhibit Book).

It is respectfully urged that in so doing the Court of Appeals for the Sixth Circuit has unwarrantedly extended the doctrine of res adjudicata to the detriment of the public and the respondent, and has unwarrantedly extended the finding of the Court of Appeals for the First Circuit as to Hagen's inventive step.

POINT VI. This Court in the public interest should exercise its supervisory authority and review the decision of the Court of Appeals for the Sixth Circuit, determining the validity of both patents in the light of the record in this case, the admissions of the respondent herein and the respondent's presently urged theory of 100% overlapping of the vanes in fully open position, which is an incident to several prior art patents. If this Court should determine the patents in suit to be valid, the rights of the public should be definitely determined by fully defining the meaning and scope of the claims, inasmuch as this has not been done by any court

considering them but which, without attempting to apply to Exhibits B and C, the Court of Appeals for the Sixth Circuit has, on the basis of results accomplished, extended to cover prior art patents having spin control vanes overlapping in space.

The paramount interest of the public is well stated in *Motion Picture Patents Corporation* v. *Universal Film Corporation*, 243 U. S. 502. It was restated in *United States* v. *Masonite Corporation*, 316 U. S. 265, again in *Mercoid Corporation* v. *Mid-Continent Investment Co.*, 320 U. S. 661, and as late as May 21, 1945, in *Sinclair & Carrol* v. *Interchemical Corporation* (not reported).

The Court of Appeals for the First Circuit left no reason for expanding Hagen's inventive act or his claims in suit, certainly not to expand them on the 100% overlapping of vanes in fully open non-functioning position theory, or overlapping in space theory, when all vanes of the prior art overlap in space and form directing passages between them to the same extent as in Exhibits B and C. The Court of Appeals for the Sixth Circuit has held Exhibits B and C which have no overlap whatever in closed position to infringe. In fact, in Exhibit C there are substantial spaces between the vanes when closed and there is mere edge to edge contact in Exhibit B.

Respondent urged its theory of 100% overlap in fully open position in this case because there is no such overlap as described by the Court of Appeals for the First Circuit when the vanes are closed, or such as is called for by the language of the claim of the first Hagen patent. In no position of adjustment is there an overlapping such as pointed out by the Court of Appeals for the First Circuit in likening the vanes to barrel staves (122 Fed. 2d 900, at page 905, column 2),

> "In likening Hagen's vanes to the staves of a barrel it must be borne in mind that, when in closed position,

they do not meet edge to edge like barrel staves, but overlap one another."

It is respectfully urged that public interests require that this Court should review this case and if the Court should determine the claims to be valid, then the rights of the public should be determined by this Court's fully determining the meaning and scope of the claims, which has not been done by the Court of Appeals for the Sixth Circuit in holding Exhibits B and C to infringe on the basis of results. Neither the District Court nor the Court of Appeals for the Sixth Circuit made any attempt to apply the claims in suit to the structures Exhibits B and C, but found infringement on the basis of results accomplished, thereby extending the claims to cover prior art patents having spin control vanes overlapping in space and accomplishing substantially the same results in substantially the same way by using the same or equivalent means. In so doing the Court of Appeals for the Sixth Circuit has by judicial decree given to Hagen (respondent) what has long been a part of the public domain, and we respectfully urge that this Court should act to protect the public interest in this important matter.

Conclusion

WHEREFORE, the petitioner earnestly prays that the petition for writ of certiorari be granted, the cause reviewed, and the decree of the Court of Appeals for the Sixth Circuit reversed.

Respectfully submitted,

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Office - Supreme Court, U. S.
FILED
JUL 31 1945
CHARLES ELMORE CROPLEY
CLERK

In the

Supreme Court of the United States.

OCTOBER TERM, 1945.

No. 150.

CLARAGE FAN COMPANY

v.

B. F. STURTEVANT COMPANY.

RESPONDENT'S BRIEF

IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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TABLE OF HEADINGS.

	Page
STATEMENT OF THE CASE	1
HISTORY OF THE LITIGATION	4
PETITIONER'S CONTENTIONS	5
SUMMARY OF ARGUMENT	7
ARGUMENT	8
No Change in Theory by Respondent	8
Petitioner's Attempt to Seek a Review of the Facts Bearing on Validity	9
Concurrence of Decisions	11
The Cases Cited by Petitioner	13
CONCLUSION	14

TABLE OF CASES CITED.

B. B. Chemical Co. v. Ellis, 314 U. S. 495	2
Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84	14
Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U. S. 275	11
General Electric Co. v. Wabash Appliance Co., 304 U. S. 364	13
Hanovia Chemical & Manufacturing Co. v. David Buttrick Co., 127 F. (2d) 888	11
Morton Salt Co. v. G. S. Suppiger Co., 314 U. S. 488	2
Mercoid Corp. v. Mid-Continent Inv. Co., 320 U. S. 661	2, 5, 13
Motion Picture Patents Corp. v. Universal Film Corp., 243 U. S. 502	13

Page

B. F. Sturtevant Co. v. Mass. Hair & Felt Co., 31 F. Supp. 975, 122 F. (2d) 900, 124 F. (2d) 95, cert. den. 315 U. S. 823 1

B. F. Sturtevant Co. v. Clarage Fan Co., 50 F. Supp. 157, 148 F. (2d) 786 1

Sinclair & Carroll Co. v. Interchemical Corp., 62 S. Ct. 1143 14

United States v. Masonite Corp., 316 U. S. 265 . . 2, 13

United Carbon Co. v. Binney and Smith Co., 317 U. S. 228 13

Williams Mfg. Co. v. United Shoe Machinery Corp., 316 U. S. 364 11

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RESPONDENT'S BRIEF

IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

STATEMENT OF THE CASE.

The present petition is the second attempt by the Clarage Fan Company to have this Court review decisions holding respondent's patents valid and infringed by apparatus made by the petitioner.

The first attempt grew out of a suit for infringement brought in the District of Massachusetts by respondent against a user of apparatus made by the Clarage Fan Company,* in which suit the latter company, although declining to become a party defendant in name, nevertheless openly and admittedly assumed and entirely conducted the defense of the case. This present and second attempt follows a suit brought in the District of Michigan by respondent against the Clarage Fan Company itself.†

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* *B. F. Sturtevant Co.* v. *Mass. Hair & Felt Co.*, 31 F. Supp. 975, 122 F. (2d) 900, 124 F. (2d) 95, cert. den. 315 U.S. 823.

† *B. F. Sturtevant Co.* v. *Clarage Fan Co.*, 50 F. Supp. 157, 148 F. (2d), 786.

In both suits the same patents were held valid and infringed by the same identical apparatus, to wit, apparatus embodying and employing a Vortex control exemplified by a physical specimen present at both trials as Exhibit 3. In the *Michigan* suit, two other forms of Vortex control, identified as Exhibits B and C were held to "embody no substantial departure from the patented apparatus or from Exhibit 3, but are merely colorable departures therefrom and attempted evasions of the claims in suit." (I-44*.) Apparatus embodying or employing these slightly modified Vortex controls was also held to be infringements of each and every claim in suit.

In the first petition to this Court (Case No. 968, October Term, 1941) the petitioner based its prayer for review on an alleged "extension of monopoly". There was no basis or justification for such a charge. This Court denied the petition (315 U.S. 823).

In the present petition, precisely the same charge is made but now it is presented under the guise of "the public interest" having been overlooked or not properly considered. This is an attempt by petitioner to have this Court believe that this case is similar to several recent cases wherein patentees had attempted to go beyond their patent rights in disregard of the public interest. We refer to such cases as the *Morton Salt* case,[1] the *B. B. Chemical* case,[2] the *Masonite* case[3] and the *Mercoid* case[4]. In all of these the patentees had not been content to enjoy the limited rights conferred by their patent claims but had attempted to expand those

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* We shall refer to the two volumes of the Transcript of Record as "I" and "II".

[1] *Morton Salt Co.* v. *G. S. Suppiger Co.*, 314 U.S. 488.

[2] *B. B. Chemical Co.* v. *Ellis*, 314 U.S. 495.

[3] *United States* v. *Masonite Corp.*, 316 U.S. 265.

[4] *Mercoid Corp.* v. *Mid-Continent Inv. Co.*, 320 U.S. 661.

rights to unpatented things which were free to the public to make, sell and use. In short, the practices of the patent owners were in disregard of the interests of the public, and this Court properly denied relief in such cases.

But every patent owner does not necessarily act contrary to the public interest. Nevertheless, this Court may well expect that many an adjudged infringer will, when all else fails, raise the cry of "the public interest" and petition this Court for a review of his case, even though in fact the alleged "public interest" about which the petitioner raises his voice is nothing more than the personal and private interest of a defeated litigant. Such is the situation here.

This is just an ordinary patent infringement suit in which the Clarage Fan Company, in two different circuits, has been adjudged to be an infringer of respondent's patents. Respondent has made no improper or illegal use of its patents. It has not attempted any extension of its patent rights beyond the limit of the patent grant. It has not entered into any illegal or improper license agreements under its patents and it has in no way attempted to use its patents to control the sale or use of unpatented goods. It has done nothing in derogation of the public interest.

There is no reason for the grant of the writ. There is no conflict of decisions between the Circuit Courts of Appeals. There is no question of local law or federal law which has not been or which should be settled by this Court or which has been decided by the Sixth Circuit Court of Appeals in a way which might conflict with the applicable decisions of this Court. The Circuit Court of Appeals has not departed from the accepted and usual practice of judicial proceedings such as to call for an exercise of this Court's power of supervision.

HISTORY OF THE LITIGATION.

The statement of facts on page 2 of the petition is correct, so far as it goes. However, we think it necessary to amplify the history of the case as follows:

In the present suit, the plaintiff B. F. Sturtevant Company (respondent herein) asserted that the issue of validity of the patents and the issue of infringement by apparatus employing Exhibit 3 were *res adjudicata,* Clarage having openly assumed and conducted the defense of the *Massachusetts* case. The plaintiff also charged that apparatus embodying two modifications of Exhibit 3, which modifications were not before the courts in the *Massachusetts* case, were likewise infringements of the patents. These are the Vortex controls, Exhibits B and C.

After a full trial, during which, over respondent's objections, petitioner was permitted to put in all the prior art and testimony it desired in an attempted attack on the validity of the patents, the District Court filed its Findings of Fact and Conclusions of Law September 7, 1943. It held that the validity of the patents and their infringement by Exhibit 3 were *res adjudicata;* and further held that Exhibits B and C were substantially like Exhibit 3, appropriated the principle and mode of operation of the patented apparatus, obtained substantially the same results in substantially the same way by using the same or equivalent means, embodied no substantial departure from the patented apparatus or from Exhibit 3, and were infringements of each and every claim in suit. (Conclusions of Law I-43, 44.)

The Circuit Court of Appeals for the Sixth Circuit affirmed the judgment of the District Court in all respects. Opinion (II-412, Amended II-423) (148 F. 2d 786).

It is from the decree (II-411) of the Sixth Circuit Court of Appeals that Clarage Fan Company brings its present petition to this Court.

PETITIONER'S CONTENTIONS.

The petitioner vigorously contended in the District Court and in the Circuit Court of Appeals that respondent had shifted its position or theory of the claims from that presented in the *Massachusetts* case, in other words, that respondent had urged one interpretation in the *Massachusetts* case and had advanced another interpretation in the present case in order to support the charge of infringement by Exhibits B and C. Petitioner contended that this reopened all questions of validity and infringement and relied upon *Mercoid Corporation* v. *Mid-Continent Investment Company* (320 U.S. 661) as authority for not following the rule of *res adjudicata.*

Whether or not a change of theory by plaintiff could ever result in refusal of a court to apply the rule of *res adjudicata* is a question of law which respondent did not consider necessary to argue at length in the courts below. Respondent demonstrated to the satisfaction of the District Court that as a matter of *fact* there had been no such change of theory and that the interpretation of the patented claims adopted by the plaintiff in this case was identical with that in the *Massachusetts* case. The District Court made the following Finding of Fact:

> "32. In the theory of a 100% overlap when the vanes are in fully open position, there is no such shifting of theory by plaintiff from that taken by it in the *Massachusetts* case, as to warrant refusal to apply the doctrine of *res adjudicata.*" (I-43.)

On appeal the Circuit Court of Appeals carefully considered the question of *res adjudicata.* The Court said, "We do not think that the question of validity is again presented but we give consideration to appellant's insistence." (II-418.) The Court then proceeded to give an analysis of the

findings of the Master and the opinion of the First Circuit Court of Appeals. The Court found as a matter of *fact* that the *same* issue of validity was presented in the First Circuit as in the Sixth Circuit. In summation of this point the Court below said:

> "Contrary to appellant's contention that this conception of overlapping in space was not present in the *Massachusetts* case, we find numerous references to it in the testimony in that case and we can reach no other conclusion, if at all material, than that it was the basis of the court's holding of validity. The same issue as to validity was presented there in the same terms as here, and we think that the validity of No. 863 is *res adjudicata.*" (II-420.)

And in respect to the second Hagen patent, the Court said:

> ". . . in so far as the patent is attacked on the ground that appellee has shifted its position from that taken in the *Massachusetts* case, what we have said with reference to No. 863 applies here." (II-421.)

Petitioner also presented in the District Court and in the Circuit Court of Appeals an extensive argument attempting to show invalidity of the patents over the prior art. A similar argument is presented here. Furthermore, the petitioner especially assails the validity of the second Hagen patent. Precisely the same attack was made in the petition presented to this Court in the *Massachusetts* case. This effort to present an issue concerning validity is no more than a second attempt to seek a review of the facts decided by the Circuit Court of Appeals for the First Circuit in the *Massachusetts* case.

SUMMARY OF ARGUMENT.

We shall argue that the petition should be denied because:

There has been no shift of position or change of interpretation by the plaintiff between the *Massachusetts* case and this case; and the courts below on full consideration of the facts and giving "consideration to appellant's insistence" held that the same issues were presented in the same terms in both suits.

Petitioner's argument on validity is nothing more than a reargument of the issues of fact decided in the *Massachusetts* case and should not be countenanced.

The concurrent findings by the several tribunals that have passed on this litigation should not be disturbed.

The petitioner makes, and could make, no showing of improper actions or actions against the public interest by respondent. There is no question of illegal or improper use of the patents or any such improper actions as existed in any of the cases cited by the petitioner.

ARGUMENT.

No Change in Theory by Respondent.

Petitioner's principal argument is based on the following statement on page 14 of its brief:

> "In order to urge infringement by Exhibits B and C respondent evolved its present overlapping in space theory, 100% overlap with vanes in fully open position in which position they perform no work."

The petitioner presents this as if it were a wholly new theory developed by respondent for purposes of this case and inconsistent with the theory advanced by respondent in the *Massachusetts* case. That assertion is false and its falsity is exposed in the opinion of the court below. The same theory that was advanced in this case was advanced in the prior suit. It formed the basis of the testimony of plaintiff's expert, Berry, who is the same expert in the present case. Even defendant's expert, Russell, in the prior case testified in answer to a question by the Master that "when they (the vanes) are wide open, sir, the overlap is 100 per cent". This testimony appears in the record of the prior case which is Exhibit 6A in this case, page 427. No contention was made by the defendant in the *Massachusetts* case that overlap should be construed any differently from the interpretation advanced by the plaintiff. The Master and the First Circuit Court of Appeals adopted this interpretation of overlap as adequately shown by the opinion of the Court below (II-419, 420), whose conclusion we have quoted on page 6, *supra.*

What the petitioner seeks to do is to have this Court find as a matter of *fact,* contrary to the findings of the courts below, that respondent shifted its position in the present case, and then to hold as a matter of *law* that such a shift would warrant the application of petitioner's interpretation

of the *Mercoid* doctrine. Regardless of the law, the whole argument falls at the start on the false issue of fact which the petitioner presents to this Court.

Petitioner's Attempt to Seek a Review of the Facts Bearing on Validity.

The petitioner, not content with asserting that the case should be reopened because of an alleged shift of theory, presents before this Court a direct attack on the validity of the patents.

Thus, on pages 10 and 11 and elsewhere, petitioner asserts that overlapping in space is an incident to all adjustable multiple vane controls, that respondent has been permitted to reclaim and recapture admittedly ancient principles of spin control, that it is merely a matter of mechanics or a mechanical expedient to construct a fan in accordance with the patents, and that the courts below have given the claims such scope as to embrace prior art structures.*

Petitioner also asserts, as though it were something new, that Hagen "admits" that his second patent is merely an adaptation of the first Hagen patent to a forced draft fan. (Question 3, page 8, Point II, page 16.) But there is nothing new in that. We have always taken the position that the second patent is a specific application to a forced draft fan of the principles broadly disclosed in the first patent. The

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* Petitioner's contentions are wholly inconsistent with statements made by petitioner in technical bulletins. See Exhibit 16 (II-317) describing a Vortex control which is a substantial copy of the second Hagen patent and stating that Vortex control " is something entirely new in principle" (II-317), "for it is revolutionary and something which engineers generally have never heard of before" (II-318), and also Clarage Bulletin No. 101 (II-305, 313) wherein it is stated: "Clarage Vortex control and its applications to systems, protected by patent coverage, are among the most outstanding improvements ever made in the field of fan engineering" (II-306, 314).

opening paragraphs of the second Hagen patent itself set forth that fact and we so stated on page 4 of our brief before this Court in Case No. 968, October Term 1941, when the petitioner was asserting that the second Hagen patent was invalid on the ground that it relied upon the same inventive concept underlying the first patent. (Point 3, page 25 of petitioner's brief in Case No. 968.)

Thus petitioner's present argument is nothing more than a second attempt to have this Court review the multitude of issues of fact decided in 1941 by the First Circuit Court of Appeals. The decision of that Court is binding on the parties to this suit, and petitioner's attempt to review that decision should not be entertained. Nevertheless, we take this opportunity to point out that petitioner's glib statements as to overlap, ancient principles, mechanical expedients, etc., are a gross over-simplification of the case.

Because of the complex technical aspects of the case it was referred for trial to a Special Master who spent six full days in hearing the parties. There was much fact and expert testimony offered by both sides and in the course of its presentation there was full discussion of such matters as centrifugal fans of both the induced and forced draft types, the control of such fans by dampers, by variable speed and by adjustable inlet vanes, the effect of these various controls on the pressure-volume and horse-power characteristics of the fans, and the relations of the controlled output of the fans to the changing demands of a system. Involved in the case were such highly technical matters as velocity components, vector diagrams, shock-free entry, tangential admission, shock loss, cavitation, work, fluid flow in a vortex, throttling, and others too numerous to mention.

All of these technical matters were carefully considered by the Master, the District Court and the Circuit Court of Appeals in the *Massachusetts* case. They were likewise

considered, so far as necessary for a decision on the question of change of theory and the question of infringement by Exhibits B and C, by the District Court and the Sixth Circuit Court of Appeals in this case.

The First Circuit Court of Appeals in *Hanovia Chemical & Manufacturing Co.* v. *David Buttrick Co.* (127 F. 2d 888 @ 891) had occasion to refer to the *Massachusetts* case and point out that:

> "In the Sturtevant case, both the nature of the machines of the prior art and the nature of the machines covered by the patents there in suit,—what each did and how each operated,—presented complicated and hotly disputed issues of fact which, for intelligent solution, called for an evaluation of the testimony of expert witnesses."

To entertain this petition is to require this Court to review the "complicated and hotly disputed issues of fact" on which the courts of two circuits have already passed.

Concurrence of Decisions.

In this case the petitioner attempts to bring before this Court issues of fact which have been concurrently decided against petitioner by both courts below. These concurrent decisions should not be disturbed.

In *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U.S. 275 @ 278, this Court said:

> "It must be a strong case in which this court will set aside these concurrent findings of two courts."

And in *Williams Mfg. Co.* v. *United Shoe Machinery Corp.*, 316 U.S. 364 @ 367, this Court said,

> "These are findings of fact, despite the petitioner's apparent contention to the contrary, and we will not

disturb such concurrent findings where as here, there is evidence to support them."

There is not only concurrence of the decisions of the two courts below, but a remarkable degree of concurrence on all fact issues by the several tribunals before which the parties have contended in this litigation.

The validity of the first Hagen patent has been concurred in by the Special Master, the Massachusetts District Court and the First Circuit Court of Appeals. The facts on which the second patent was held valid were concurred in by those same tribunals although the Master and District Court were reversed by the Circuit Court of Appeals on a question of law.

In the present suit, the validity of the patents and their infringement by Exhibit 3 were held to be *res adjudicata* by both courts below. The issue of infringement by the modified constructions, Exhibits B and C, was not before the courts in the *Massachusetts* case but was tried on the merits by the *Michigan* District Court. That court and the Sixth Circuit Court of Appeals concurred in the finding of infringement. That finding is obviously a concurrence with the tribunals of the First Circuit as to what constitutes an infringement of the patents.

On the issue of interpretation of the claims, all tribunals are in agreement. Both the *Michigan* District Court and the Sixth Circuit Court of Appeals concur in the finding that plaintiff did not shift its position.

Thus on all issues of fact presented to the various courts which have passed upon this subject matter, there is a remarkable unanimity of opinion. The concurrence goes far beyond that existing in the *Goodyear* and *Williams* cases, *supra*.

The Cases Cited by Petitioner.

No case cited by petitioner in any way supports the propositions advanced in the petition.

The *Mercoid* case (320 U.S. 661) is asserted by the petitioner to hold that the doctrine of *res adjudicata* will not be applied in contravention of the public interest. But that case involved a clear "misuse" of the patent right, an attempt to expand the grant of the patent to unpatented devices. The controversy centered about a certain license agreement under which the royalties were based on an unpatented element.

Motion Picture Patents Corp. v. *Universal Film Corp.*, 243 U.S. 502 and *United States* v. *Masonite Corp.*, 316 U.S. 265, likewise involved attempts to enlarge the patent grant, the former case relating to a notice attached to a motion picture projector to limit its use to film of a certain manufacture, and the latter relating to a flagrant price-fixing agreement.

The present case has nothing whatever in common with any of these cited cases. The respondent is not guilty of entering into any restrictive license arrangements. The respondent seeks only to enforce its valid patent rights against an adjudged infringer.

The other cases cited by petitioner are equally irrelevant. For example, *United Carbon Co.* v. *Binney and Smith Co.*, 317 U.S. 228 and *General Electric Co.* v. *Wabash Appliance Co.*, 304 U.S. 364 involve the question of claims which are indefinite and describe a product by its function. Both of those cases involved *products* (carbon black and lamp filament material) which were claimed in an indefinite and functional manner.

There is nothing indefinite about the claims of respondent's patents. They call for *structures*, and when the underlying physical considerations are understood, there is no

uncertainty in their interpretation. The claims were applied to Exhibit 3 without difficulty by the three tribunals that heard the *Massachusetts* case, and to Exhibits B and C by the two courts below.

Cuno Engineering Corp. v. *Automatic Devices Corp.*, 314 U.S. 84 and *Sinclair & Carroll Co.* v. *Interchemical Corp.*, 62 S. Ct. 1143, are simply cases holding no invention. In view of the concurrent holdings of all tribunals in both circuits on the issues of fact bearing on invention, we believe that no further argument is necessary beyond what we have presented, pages 9–11, *supra*.

CONCLUSION.

Rule 38 of this Court states that a review on writ of certiorari "will be granted only where there are special and important reasons therefor".

Petitioner brings forward nothing but an effort to reargue the issues of *fact* in litigation in which it has been consistently defeated in two circuits.

There is not a grain of evidence, and petitioner makes no charges, to support any contention of misuse of patents, attempted extension of the patent grant to unpatented goods, or any other improper action by respondent.

There are no special and important reasons to justify grant of the writ and we pray that it be denied.

Respectfully submitted,

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